

October 19, 2006

REMARKS

Claims 1-2 and 4-10 will stand pending in the instant application.

**Response to the Restriction Requirement and Request for Rejoinder**

Each of instant claims 1 and 7, drawn, respectively, to a composition and a method of use thereof, recites the same features with no intervening features. Further, for at least the reasons set forth below, instant claims 1-2 and 4-6 are allowable as written. Because the instant composition of Group I, claims 1-2 and 4-6, are allowable as written and because the instant method claims, Group II, claims 7-10, of using the same composition incorporate all of the features of instant claim 1 therein, Applicants request rejoinder of all of the claims of Groups I and II. It is well settled that a composition and a method of using the same composition are drawn to the same invention. See In re Ochiai, 37 USPQ2d 1127 (Fed Cir. 1995). Accordingly, Office practice dictates that rejoinder of Groups I and II is proper in this case. See MPEP 8.21.04, 1<sup>st</sup> and 2<sup>nd</sup> paragraphs.

**Rejections Under 35 USC §103(a)**

Claims 1 and 4 stand rejected under 35 USC section 103(a) as being obvious over O'Keefe et al. (O'Keefe) in view of Decker et al. (Decker), both of record. The Applicants respectfully traverse this rejection.

The rejection admits that O'Keefe fails to disclose a semi-crystalline polyester resin formed from a polyol and a polycarboxylic acid such that the polycarboxylic acid comprises 10 to 50 phr of the total weight of total polycarboxylic acid used to form the said semi-crystalline polyester is an asymmetrically substituted aromatic polyacid, ester, acid halide, anhydride, or a mixture thereof, as is instantly recited in instant claims 1 and 7.

Contrary to the position taken in the rejection where it alleges on page 3, item 1, that it "uses Decker solely to teach the use of 10 wt.% asymmetrically [sic] substituted polyacid", Decker may not be combined with O'Keefe to supply an intermediate to meet the instantly claimed semi-crystalline polyester. The law is well settled that where the art lacks motivation to stop at an intermediate

AMENDMENT AND RESPONSE

Ser No. 10/615,685

October 19, 2006

compound, that art may not be combined with another piece of art to include such an intermediate compound. *In re Lalu*, 747 F.2d 703 (Fed. Cir. 1984) and MPEP 2145.X.D.2. At best, Decker can suggest only the desirability of forming the polyester adduct and using the adduct in a final composition. See Decker at Abstract, lines 7-15, col. 1, line 64 to col. 2, line 9, and col. 3, lines 47-53. Accordingly, no combination of O'Keefe and Decker can be made to use an intermediate of Decker in O'Keefe as a final product.

In addition, Decker teaches away from the use of semi-crystalline polyesters because of sintering problems, which lead to clumping and thereby destroy the sprayability and the operability of the powder. See Decker at col. 1, lines 43-49, especially lines 45-49. Consistent with the rule in Lalu, discussed above, it is improper to combine Decker with O'Keefe as the rejection tries to do to provide a semi-crystalline polyester intermediate disclosed in Decker. See the MPEP 2145.X.D.

Clearly then, in taking the art as a whole, there can be no suggestion to make the combination attempted by the rejection. Because the combination of O'Keefe and Decker is improper it cannot render the instant claims obvious.

Claim 2 stands rejected under 35 USC §103(a) as being obvious over O'Keefe and Decker in view of Ahjopalo, all of record. The Applicants respectfully traverse these rejections.

In addition to its shortcomings, mentioned above, the rejection admits that O'Keefe fails to disclose non-blooming polyesters, instantly recited in claim 2.

Like O'Keefe, Decker fails to disclose, teach or suggest a semi-crystalline polyester resin formed from a polyol and a polycarboxylic acid such that the polycarboxylic acid comprises 10 to 50 phr of the total weight of total polycarboxylic acid used to form the said semi-crystalline polyester is an asymmetrically substituted aromatic polyacid, ester, acid halide, anhydride, or a mixture thereof, as is instantly recited.

The art of Ahjopalo fails to disclose, teach or suggest the missing semi-crystalline polyester resin formed from a polyol and a polycarboxylic acid such that the polycarboxylic acid comprises 10 to 50 phr of the total weight of total

AMENDMENT AND RESPONSE

Ser No. 10/615,685

October 19, 2006

polycarboxylic acid used to form the said semi-crystalline polyester is an asymmetrically substituted aromatic polyacid, ester, acid halide, anhydride, or a mixture thereof, as is instantly recited. Accordingly, the art of Ahjopalo fails to remedy the deficiencies of either of O'Keefe or Decker. As even the combination of Ahjopalo with O'Keefe or Decker fails to meet every feature of the instant claims, the instant claims are patentable over Decker taken in view of Ahjopalo or over O'Keefe taken in view of Ahjopalo.

Although no rejection on the record states that O'Keefe is taken *in view of Decker and further in view of Ahjopalo*, the instant claims are patentable in view of this combination because, as shown above, the attempted combination of O'Keefe and Decker (to use semi-crystalline polyester intermediates of Decker to modify the O'Keefe final coating powder) is improper.

Claims 5 and 6 stands rejected under 35 USC §103(a) as being obvious over O'Keefe and Decker in view of Daly. The Applicants respectfully traverse these rejections.

As stated in the discussion of the rejections of instant claims 1, 2 and 4, above, each of Decker and O'Keefe fails to disclose, teach or suggest any semi-crystalline polyester resin formed from a polyol and a polycarboxylic acid such that the polycarboxylic acid comprises 10 to 50 phr of the total weight of total polycarboxylic acid used to form the said semi-crystalline polyester is an asymmetrically substituted aromatic polyacid, ester, acid halide, anhydride, or a mixture thereof, as is instantly recited.

Daly fails to make up for any of the deficiencies of either Decker or O'Keefe because Daly fails to disclose the instantly recited semi-crystalline polyesters from an asymmetrically substituted aromatic polyacid, ester, acid halide, anhydride, or mixture thereof, as is instantly recited.

Further, the combination of O'Keefe and Decker is improper, as discussed above, and cannot supply the instant claim features missing in Daly.

All of the remaining rejections are improper and Applicants respectfully request their withdrawal.

AMENDMENT AND RESPONSE  
Ser No. 10/615,685

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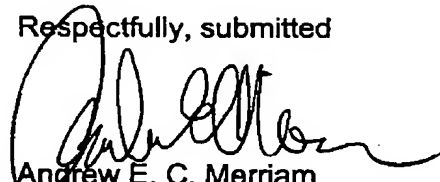
October 19, 2006

CONCLUSION

Based on the foregoing, the instant claims are believed to be in current condition for allowance. An early and favorable response is earnestly solicited. If the examiner has any questions problems concerning the instant application, she is urged to contact the undersigned at the number given below.

No fees are believed due. In the event that any fees are found owing, please charge deposit account no. 18-1850.

Respectfully, submitted



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